

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

CYTIVA SWEDEN AB, and  
GLOBAL LIFE SCIENCES  
SOLUTIONS USA LLC,

Plaintiff,

v.

BIO-RAD LABORATORIES, INC.,

Defendant.

Civil Action No. 18-1899-CFC

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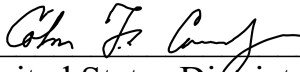
**ORDER**

Pending before me is Plaintiffs' motion to exclude at trial the damages-related opinions of Defendant's expert Dr. Thomas Kearl that are based on license agreements for technology that is not comparable to the technology covered by the patents Plaintiffs have accused Defendant of infringing. D.I. 172. I will grant the motion.

Federal Circuit precedent requires that for a license to be used in an expert's damages analysis, the license must be proven comparable to the license that is the subject of the hypothetical negotiation upon which the expert's proposed reasonable royalty rate is based. *M2M Sols. LLC v. Enfora, Inc.*, 167 F. Supp. 3d 665, 678 (D. Del. 2016). Defendant does not dispute that Dr. Kearl's opinions are based in part on licensing agreements that are not comparable to the license that is

the subject of the hypothetical negotiation in this case. *See* D.I. 209 at 19 (noting that “no party contends [that the nine licenses] are comparable”). It argues, however, that Dr. Kearl’s “limited discussion” of the nine licenses is permissible because “[t]hese licenses are reflective of industry practice, which is relevant to the *form* of the reasonable royalty.” D.I. 209 at 19 (emphasis in original). That Dr. Kearl’s discussion of the nine licenses is limited or offered merely to confirm his opinion about the form of a reasonable royalty is of no moment. Defendant “cannot escape th[e] [comparability] requirement by suggesting that the incomparable licenses only played a minor role [in its expert’s analysis], instead of being a driving force in the reasonable royalty estimate.” *M2M*, 167 F. Supp. 3d at 678.

Now therefore, at Wilmington on this first day of June in 2021, Plaintiffs’ Motion to Exclude Expert Opinions of Dr. Thomas Kearl (D.I. 172) is  
**GRANTED.**

  
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United States District Judge